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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: ROCHE et al.  
Serial No.: 10/789,665  
Filed: February 27, 2004

Group Art Unit: 7553  
Examiner: H.Q. Pham

DATE: 9/7/2007

I hereby certify that this paper and the documents identified herewith are being deposited this date with the United States Postal Service as first-class mail in an envelope addressed below, or being facsimile transmitted to the USPTO at (571) 273-8300, on the date set forth above.

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Sir:

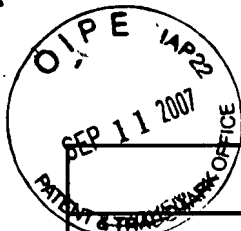
Enclosed please find:

- Application Initiated Interview Request Form (2 pages)
- Request For Reconsideration And Amendment After Final Pursuant To 37 CFR 1.116 (14 pages)
- Examiner Interview Summary (5 pages)

Respectfully submitted,  
Innovation Management Sciences

By

Wilfred Lam  
Reg. No. 41,923  
Attorney for Assignee



### Applicant Initiated Interview Request Form

Application No.: 10/789,665 First Named Applicant: Matthew J. Roche  
Examiner: Hung Q. Pham Art Unit: 2168 Status of Application: Finally rejected

#### Tentative Participants:

(1) Examiner Pham (2) Wilfred Lam  
(3) Jonathan Small (4) \_\_\_\_\_

Proposed Date of Interview: 9/4/2007 Proposed Time: 2 (~~AM~~PM)

#### Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: \_\_\_\_\_

### Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej</u>	<u>1-9, 20, 21, 23,</u>	<u>Musgrove</u>	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input checked="" type="checkbox"/>
(2) _____	<u>24, 31-33</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>Rej</u>	<u>20, 21, 23, 24</u>	<u>No</u>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

#### Brief Description of Arguments to be Presented:

See attached Outline/Agenda transmitted to Examiner Pham prior to interview

An interview was conducted on the above-identified application on September 4, 2007.

**NOTE:** This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Wilfred Lam  
Applicant/Applicant's Representative Signature

\_\_\_\_\_  
Examiner/SPE Signature

Wilfred Lam  
Typed/Printed Name of Applicant or Representative

41,923

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Outline/Agenda for Examiner Interview

1. Summary of applicant's view of invention
2. Summary of applicant's view of distinguishing elements of invention over prior art
  - a. Musgrove/Smartshop.com – automated content gathering without user interaction (e.g., data gathering and viewing of data occurring at different point in time)
3. Discussion re 35 USC 101 – Prior Office Action rejected claims 20, 21, 23, and 24 as not producing a tangible result.
  - a. Final Office Action indicated claims are directed to energy, a non-statutory class. This appears to be the first assertion of this grounds of rejection, and should therefore not be final.
  - b. There is no paragraph 0081
  - c. There is nothing in paragraph 0024 which implies that the storage medium is signals per se.
  - d. Would an amendment limiting these claims to a physical storage medium fully address the Examiner's concerns? E.g., "A physical computer readable storage medium..."
4. Exploration of options for applicant at this point, in terms of examiner's view of claims and art
  - a. RCE with amended claims – what amendments might be effective yet not overly restrictive?
  - b. Appeal?



**PATENT APPLICATION**  
**Attorney Docket No. FORT-002-002**

**CERTIFICATE OF MAILING**

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Typed or printed name of person signing this certificate  
Wilfred Lam

Signature: \_\_\_\_\_

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): ROCHE et al.	)	Confirm. No. : 7553
	)	
Appl. No. : 10/789,665	)	TC/A.U. : 2168
	)	
Filed: 02/27/2004	)	Examiner: H. Q. Pham

Title: Method and System for Collecting Online Merchandising Data

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**Examiner Interview Summary**

Sir:

Pursuant to the requirements of 37 CFR 1.133(b), applicant hereby submits the following summary of an interview between Wilfred Lam, Jonathan Small, and the Examiner in the subject application held on September 4, 2007. An Applicant Initiated Interview Request Form (PTOL 413A) is submitted herewith pursuant to MPEP 7.13.04, although this form was not used to initiate the interview in this case.

## BACKGROUND

Claims 1-9, 11, 20-21, 23-24, and 26-33 are pending in the present application. All claims of the present application were finally rejected in the Office Action mailed June 28, 2007. A telephone interview was conducted on September 4, 2007, between the Examiner, the undersigned, and Jonathan Small, attorneys for applicant. The following is a summary of the interview, as required by 37 CFR 1.133(b).

## INTERVIEW SUMMARY

### A. Brief description of the nature of any exhibit shown or any demonstration conducted

No exhibits were shown nor demonstrations made.

### B. Identification of the claims discussed

Claims 1 and 20 were specifically discussed. The remainder of the claims were discussed in general terms

### C. Identification of specific prior art discussed

The Musgrove reference (USP 6,535,880) and the Smartshop.com website cited therein were discussed.

D. Identification of the principal proposed amendments of a substantive nature discussed

The examiner suggested amending claim 20 to include the limitation "computer storage medium" in order to overcome the rejection of that claim under 35 USC 101. The undersigned proposed "physical storage medium" as an alternative. It appeared that the Examiner was in agreement with this alternative.

E. General thrust of the principal arguments of the applicant and the examiner

The undersigned argued first that the general nature of the subject invention and the disclosure by Musgrove are fundamentally different. Whereas the present invention is concerned with acquiring product data from a user's interaction with that data (i.e., from a user's interaction with a product web page), Musgrove is concerned with aggregating together many web product pages so that a user need only go to one site to find a wide array of pages for that product. Where the primary objective of the present invention is to capture user interaction with different web pages, the primary objective of Musgrove is to reduce the number of different pages with which the user actually must interact.

The undersigned further argued that this is borne out by the language of the claims, and in particular claim 1. The undersigned used Fig. 1 of the Musgrove reference to illustrate the difference. It was explained that if the first location of claim 1 corresponds to the Shopping Server 20 of Musgrove, the second location of claim 1 corresponds to the Client 12 of Musgrove, and the third location corresponds to any of the Merchant Servers 40 of Musgrove, according to claim 1, product information from interactions between second and third locations being stored in the first location (claim 1) means that Musgrove would have to teach storing in

Shopping Server 20 product information from interactions between client 12 and Merchant Servers 40. However, the undersigned argued that this is not what Musgrove teaches. Rather, Musgrove teaches automated interactions between Shopping Server 20 and Merchant Server 40 in order to populate Shopping Server 20, and client-side interactions limited to interactions with Shopping Server 20 (i.e., no product information from interactions between Client 12 and Merchant Servers 40). Indeed, this is the very type of interaction from which Musgrove is attempting to free the user.

Finally, claim 20 (and its dependent claims) were discussed in light of their rejection under 35 USC 101. Applicant suggested that the grounds for rejection as being directed to a non-statutory class was first made in the Final Office Action mailed June 28, 2007, the prior rejections under 35 USC 101 being directed to lack of tangible result. As applicant was not provided an opportunity to previously respond to this ground of rejection, it was asserted that the final rejection was premature. In response, the Examiner indicated that if claim 20 was amended in a request for reconsideration to read "computer storage medium" or alternatively "physical storage medium", the amendment would be entered and the finality withdrawn.

F. General indication of any other pertinent matters discussed

No other matters were discussed.

G. General results or outcome of the interview

The Examiner's further consider Applicant's arguments by way of a Request for Reconsideration. The Examiner will enter an amendment of claim 20 to include the limitations "computer storage medium" or alternatively "physical storage medium", and withdraw the final rejection at least as to claim 20 and its dependent claims in light of 35 USC 101.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-969-8300.

Respectfully submitted,



Wilfred Lam  
Attorney for Applicants  
Registration No. 41,923

Telephone: 650-969-8300

Date: *September 7, 2007*